Remarks and Arguments

Applicants have carefully considered the Office Action dated September 20, 2006 and the references cited therein. Applicants respectfully request reexamination and reconsideration of the application.

Claims 1-22 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-31 of US Patent 6,965,912, by the same inventors. In addition, Claims 1-22 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-35 of the copending patent application publication number 2004/0205138A1 and over claims 1-24 of the copending patent application publication number 2006/0036681A1.

Applicant respectfully traverses these rejections on the grounds that the Examiner's analysis and reasoning in support of the rejection do not comply with the standards set forth in the M. P. E. P. 804(II)(B)(1) which specifically states:

> Any obviousness- type double patenting rejection should make clear:
>
> (A) The *differences* between the inventions defined by the conflicting claims -- a claim in the patent compared to the claimed in the application; and
>
> (B) The reasons why a person of ordinary skill in the art would conclude that the inventions defined in the claim in the issue is an obvious variation of the inventions defined in a claim in the patent.
>
> (*emphasis* added)

In setting forth the grounds for the rejection, the Examiner has only alleged that the subject claims are broader, but in all instances has not identified the *differences* between the inventions claimed in the subject application and the cited patent or published pending applications. Accordingly, the Examiner has not made a limitation by limitation analysis, that identifies the differences between the limitations in each of the alleged conflicting claims, and, therefore, given the Applicant an opportunity to evaluate whether such differences are non-obvious under the *Graham vs. John Deere* standard.

Applicants respectfully traverse the rejection of claim 3-5 under 35 USC 101 as being directed to nonstatutory subject. For a considerable time now the USPTO has allowed claims in the form of "a computer data signal embodied in a carrier wave." A search of the publicly accessible portion of the USPTO database (www.uspto.gov) reveals that multiple United States patents issued since 1976 have issued in this form. Typical examples can be seen in the following US Patents and their respective claims:

6,112,240	Claims 38-48
6,131,121	Claim 12
6, 182,279	Claims 21-32
6, 185,184	Claim 14-16
6, 356,914	Claims 19-25

Applicants are unaware of any recent federal case law that has specifically held such subject matter as nonstatutory. In addition, Applicants respectfully request that the Examiner hold the rejection under 35 U.S.C. 101 in abeyance until a ruling in *In re Petrus ACM Nuijten*, CAFC docket No. 06-1371, U.S Patent Application Serial No. 09/211,928, regarding the patentability of electrical signals and data embedded therein.

The Examiner has objected to the disclosure of the invention and requested updating to the related application on page 1. Applicants have updated the paragraph as required by the Examiner.

Claim 5 has been objected to as depending on claim 1, which recites a computer system, rather than on claim 3, which recites a computer program product. Applicants have amended claim 5 to depend from claim 3. This amendment has not been made to distinguish over any reference of record and no narrowing of any corresponding equivalents to which the amended limitation(s) or claim(s) is/are entitled is intended by these amendments.

Claims 1-22 have been rejected under 35 U.S.C. 102(b) as being anticipated by Small, U.S. Patent No. 5,513,117, hereafter SMALL '117. Applicants respectfully traverse such rejection on the grounds that SMALL '117 can not be properly construed as prior art to the subject application. The priority date of the subject matter in SMALL '117, upon which the Examiner is relying, is after either of the priority dates to which Applicants are entitled. Specifically, the present application is a continuation-in-part of US Patent 6,965,912, Friedman et al., hereafter Friedman '912. As such, the subject

matter within the present application is entitled to either a priority date of October 18, 1999, the filing date of Friedman '912, or, August 22, 2003, the filing date of the subject continuation-in-part application. SMALL '117 is also continuation-in-part application having a filing date of July 26, 1995, but also claiming priority to parent U.S Patent 5,442,567, hereafter SMALL '567, filed April 30, 1993. Applicants have included a copy of SMALL '567 for the Examiner's benefit. A comparison of SMALL '117 with SMALL '567 clearly evidences that Figs. 4-13 and most of the specification (column 6, line 25 *et seq.*,) of SMALL '117, were not present in the parent application, and, therefore, are only entitled to a priority date of July 26, 1995, the filing date of the SMALL '117 continuation-in-part application. As such, the priority date of the subject matter in SMALL '117, upon which the Examiner is relying, is after either of the priority dates to which Applicants are entitled. Accordingly, none of the subject matter in Figs. 4-13 and column 6, line 25 *et seq.*, of the specification of SMALL '117, may properly be considered prior art against the subject application. In light of the following, Applicants respectfully assert that the current rejections based on anticipation of the pending claims by SMALL '117 are improper and should be withdrawn. If the Examiner is relying entirely on the disclosure within SMALL '567 to anticipate the currently pending claims, then the Examiner has not shown where in SMALL '567 there is a teaching, disclosure, or suggestion of the subject matter, as currently claimed.

Applicants believe the claims are in allowable condition. A notice of allowance for this application is solicited earnestly. If the Examiner has any further questions regarding this amendment, he is invited to call Applicants' attorney at the number listed below. The Examiner is hereby authorized to charge any fees or credit any balances under 37 CFR §1.17, and 1.16 to Deposit Account No. 02-3038.

Respectfully submitted,

/Bruce D. Jobse/ Date: 2007-02-20

Bruce D. Jobse, Esq. Reg. No. 33,518
Rissman Jobse Hendricks & Oliverio, LLP
Customer Number 021127
Tel: (617) 367-4600 Fax: (617) 367-4656